

JUL. 30. 2004 7:40AM (3) FISH & RICHARDSON 6175428906
Applicant : Timothy L. Coder, Denis D. Hartman
Serial No. : 10/717,752
Filed : November 19, 2003
Page : 7 of 9

NO. 1764 P. 10
Attorney's Docket No.: 16076-002002

REMARKS

The comments of the applicant below are each preceded by related comments of the examiner, shown in small, bold type.

Claims 1, 2, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conti (USPN 4,326,605) in view of Heller (USPN 3,565,213).

Re: claim 1, Conti discloses an automatic wire lubricating device, comprising...

e) **an cylindrical nipple (20) formed by one of said axially displaced ends of said assembled body sections of said first and second components for attaching a bushing (19) thereon to keep from scaring the wire or to facilitate the attachment of a rubber grommet (19).**

Conti does not show the nipple is externally threaded.

Heller shows external threads (13).

To modify the apparatus of Conti so as to provide external threads would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the teachings of Morton [sic, Heller] that such an arrangement improves the ease at which the device is assembled.

The applicant respectfully disagrees.

Conti's retainer 20 did not anticipate and would not have made obvious a "cylindrical nipple ... for attaching a bushing." Conti's retainer (20) is neither cylindrical (it is apparently toroidal) nor threaded.

Heller may show external threads, as the examiner contends, but contrary to the examiner's position, to modify the apparatus of Conti so as to provide external threads would not have been obvious. First, a person of ordinary skill would not have understood how, if at all, it would have been possible to form threads on the toroidal surface of Conti's retainer. Even if it were possible, a person of ordinary skill would not have understood any reason for doing so. Conti's retainer is held captive by the geometry of a channel 21 (Conti's figure 3). Threading the outside of the retainer, even if that were possible, would serve no function. Doing so would not have made it easier to install or remove the retainer and would not have made the retainer more secure in the channel. In fact, such threads would serve no function.

JUL. 30. 2004 7:40AM (3) FISH & RICHARDSON 6175428906 NO. 1764 P. 11
Applicant : Timothy L. Coder [REDACTED] Denis D. Hartman Attorney's Docket No.: 16076-002002
Serial No. : 10/717,752
Filed : November 19, 2003
Page : 8 of 9

Claim 1 and the claims that depend on it are patentable.

10. Claims 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conti (USPN 4,326,605) in view of Oetiker (USPN 4,693,502).

Re: claim 8, Conti discloses all of the instantly claimed invention, except, tubular elements formed on opposite ends of said body sections of said first and second components which fit together so as to make a tight seal of said interior reservoir when said first and second components are fastened together.

Oetiker shows a tubular element (14), Fig. 8, formed on an opposite ends of body sections which fit together so as to make a tight seal.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Conti to include tubular elements for the purpose of improving the sealing properties of the lubrication device.

Re: claim 9, Conti discloses an internally threaded cylindrical clamping flange (24) formed by the other of the axially displaced ends of said assembled body sections of said first and second components for attaching about a threaded end of an externally threaded conduit for though which the wires are to be pulled (see column 4, lines 22-25).

Without conceding the examiner's position, claim 8 has been amended to include the feature of claim 9, which has been cancelled. The applicant disagrees with the examiner's contention that Conti shows an internally threaded flange that is (in the words of amended claim 9) "... for attaching about a threaded end of an externally threaded conduit through which the wires are to be pulled."

To the contrary, Conti's fitting 24 is--as the passage from Conti cited by the examiner makes clear--"coupled to a conduit extending to a suitable pressurized supply of lubricant." That conduit is thus clearly not the one through which the cable is pulled in Conti's device.

Re: claim 14, Conti discloses all of the instantly claimed invention except coupler pins formed on opposite ends of said body sections of the first and second components having O-rings around them and which fit together so as to make a tight seal of the interior reservoir when said first and second components are fastened together.

Oetiker shows a coupler pin (14), Fig. 8, formed on an opposite end of a body section (2) having an O-ring (15) around it and which fit together so as to make a tight seal. It would

JUL. 30. 2004 7:40AM

(3) FISH & RICHARDSON 6175428906

NO. 1764 P. 12

Applicant : Timothy L. Coder and Denis D. Hartman
Serial No. : 10/717,752
Filed : November 19, 2003
Page : 9 of 9

Attorney's Docket No.: 16076-002002

have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Conti to include an O-ring for the purpose of improvement of the seal.

Claim 14 is patentable for at least some of the same reasons as claim 1 and claim 8.

Cancelled claims, if any, have been cancelled without prejudice or disclaimer.

Any circumstance that the applicant has (a) addressed certain comments of the examiner does not mean that the applicant concedes other comments of the examiner, (b) made arguments for the patentability of some claims does not mean that there are not other good reasons for patentability of those claims and other claims, or (c) amended a claim does not mean that the applicant concedes any of the examiner's positions with respect to that claim or other claims.

Applicant requests that the examiner consider the prior art cited in an Information Disclosure Statement filed May 26, 2004, and return an initialed copy of Form 1449.

Please apply any charges or credits to deposit account 06-1050, reference 16076-002002.

Respectfully submitted,



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Date: 6/29/04

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